

REMARKS:

In view of the foregoing amendments, reconsideration and withdrawal of the outstanding Office Action rejections is respectfully requested. Claims 6-7 and 18 have been cancelled and claims 1-5, 8-10, 12-14 and 19-43 have been amended. Claims 45-48 have been added. No new matter has been added.

Applicants submit that clauses reciting preferred embodiments have been deleted from the claims in order to put the application in condition for allowance according to U.S. patent practice. Such amendments are in no way a disclaimer of the subject matter that has been deleted, and are meant only to render the scope encompassed by the claims more clear under 35 U.S.C. § 112, second paragraph.

Response to Objections

Claim 13 was objected to as indicated in the Office Action Summary, but no comments were provided thereon. Applicants presume that claim 13 has been objected to for depending from a rejected base claim. Applicants submit that claim 13, as amended, has been recast in independent form. Accordingly, Applicants respectfully request that the objection be withdrawn and that claim 13 be indicated allowable.

Response to Rejections under 35 U.S.C. § 112

Claims 1-5, 7-12, and 14-17 were rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement for the entire scope of compounds embodied by the variable groups in the claimed compound. The Examiner asserts that it would require undue experimentation for one of ordinary skill to synthesize all of the encompassed species and that the level of skill in the art is not high enough to predict properties of all of the compounds. However, the Examiner has acknowledged that the specification is enabling for the compounds listed in claim 13 and Tables 1 and 2. Without acceding to the proprieties of the Office Action rejection, Applicants submit that claims 1-5, 7-12, and 14-17, as amended, are enabled.

The enablement requirement of § 112 is satisfied when an application describes a claimed invention in a manner that permits one of ordinary skill to practice it, without undue experimentation. MPEP § 2164.01. The mere fact that experimentation might be required is insufficient to support an enablement rejection. Indeed, even complex experimentation is not necessarily undue. *Id.* Applicant respectfully submits that no undue experimentation is required to make and use the claimed invention. The question of enablement is one of predictability in view of what is known in the art. Consequently, the amount of guidance or direction needed to satisfy the enablement requirement is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. MPEP § 2164.03.

Claim 1, as amended, is directed to a compound having a piperidine ring structure (formed by Q, T, U, and V). The subject matter of claim 7 has been incorporated into claim 1 and proper Markush group language has been recited in the

claims. As such, the genus now encompassed by claim 1 requires a piperidine ring structure and is exemplified by the dozens of species in Tables 1 and 2 and throughout the specification. Applicants submit that persons of ordinary skill in the art would be able to make and use the claimed invention, despite any experimentation that might be required. Applicant further submits that this conclusion is buttressed by the amount of knowledge in the state of the art, the sheer number of examples provided in the specification, as well as the majority of Wands factors that weigh in favor of enablement of the presently claimed invention. Accordingly, Applicants respectfully request favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

Further, Applicants submit that dependent claims 2-5, 8-12 and new claims 45-48 define further embodiments of the invention that are enabled by the examples provided in the specification. Applicants submit that enabling support for the genus encompassed by these claims is found in Tables 1 and 2 and the specific compounds detailed in the specification. Accordingly, Applicants respectfully request favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112 for these additional reasons.

Withdrawn Claims

Applicants submit that withdrawn claims 19-42 have been amended to require all of the limitations of the elected invention. Applicants respectfully request that, upon an indication of allowability for the compound claims, method claims 19-42 be rejoined and allowed. See MPEP § 821.04.

New Claims

Claims 45-48 have been added to recite subject matter deleted from claims 1, 2, 5, and 10, respectively. Written description support for these claims can be found, *inter alia*, in claims 1, 2, 5, and 10, as originally presented. No new matter has been added.

Conclusions

In view of the above amendments and remarks hereto, Applicants believe that all of the Examiner's rejections set forth in the November 16, 2010 Office Action have been fully overcome and that the present claims fully satisfy the patent statutes. Applicants, therefore, believe that the application is in condition for allowance.

The Director is authorized to charge any fees or overpayment to Deposit Account No. 02-2135.

The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

Respectfully submitted,

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